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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,803	04/12/2004	Connie T. Marshall	ODS-7 Div.	5190
1473	7590	09/22/2004	EXAMINER	
FISH & NEAVE 1251 AVENUE OF THE AMERICAS 50TH FLOOR NEW YORK, NY 10020-1105			JONES, SCOTT E	
			ART UNIT	PAPER NUMBER
			3713	

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/823,803	Applicant(s) MARSHALL ET AL.	
	Examiner Scott E. Jones	Art Unit 3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2004.
 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-104 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) ☒ Claim(s) 52-54 is/are allowed.
 6) ☒ Claim(s) 1-51 and 55-104 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
 10) ☒ The drawing(s) filed on 12 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____.
 4) ☐ Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
 5) ☐ Notice of Informal Patent Application (PTO-152)
 6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The abstract of the disclosure is objected to because it exceeds 150 words as required by 37 C.F.R. § 1.72(b). Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 2, 3, 6, 8, 9, 15, 16, 18, 19, 26-36, 39-42, 48, 49, 51, 55, 56, 63-72, 76-79, 85, 86, 88, 89, and 96-102 are rejected under 35 U.S.C. 102(b) as being anticipated by Handelman (E.P. 620,688A2).

Handelman discloses a cable television gaming system including a cable television network having a multiplicity of subscriber units each having a television, receiving apparatus for receiving gaming inputs from the multiplicity of subscriber units, transmitting apparatus for transmitting to the multiplicity of subscriber units information relating to gaming results and accounting apparatus for settling gaming debts and winnings via the cable television network.

Handelman additionally discloses:

Regarding Claims 1, 18, 31, 32, 33, 34, 41, 42, 49, 51, 55, 68, 69, 70, 101, and 102:

- displaying television programming on user equipment (Column 2, lines 35-42, Column 8, lines 11-20, and Column 9, lines 37-43);

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- displaying a notification as an overlay on top of the television programming that informs the user of an interactive wagering opportunity (Column 11, line 42-Column 12, line 14, and Column 17, lines 38-47);
- providing the user with an opportunity to respond to the notification by pressing a remote control key on a remote control 164 (Column 13, lines 41-47, and Figure 7B);
- automatically providing the user with an opportunity to electronically place a wager with the interactive wagering application in response to the pressing of the remote control key (Column 11, line 42-Column 12, line 14, Column 17, lines 38-47, Column 13, lines 41-47, and Figure 7B).

Regarding Claims 2, 35, and 71:

- displaying television programming comprises displaying a television channel containing programming that is not related to wagering. The basic cable television network typically has a plurality of television stations not related to wagering (Column 2, lines 35-42, Column 35, lines 2-5, and Figure 27C).

Regarding Claims 3, 36, and 72:

- displaying television programming comprises displaying a wagering television channel (Column 2, lines 35-42).

Regarding Claims 6, 39, and 76:

- the notification includes a prompt asking the user to press a given remote control key to be presented with an opportunity to sign up for an interactive wagering service (Column 13, lines 41-47, and Figures 1-26).

Regarding Claims 7, 40, and 77:

- the notification includes a prompt asking the user to press a given remote control key to be presented with an opportunity to subscribe to a wagering television channel (Column 13, lines 41-47, and Figures 1-26).

Regarding Claims 8 and 78:

- the notification includes a prompt asking the user to press a given remote control key to be presented with an opportunity to sign up for an interactive wagering service, and the wagering application displays on-screen enrollment options to the user when the user presses the given remote control key (Column 13, lines 41-47, and Figures 1-26).

Regarding Claims 9 and 79:

- the notification includes a prompt asking the user to press a given remote control key to be presented with an opportunity to sign up for an interactive wagering service; and the wagering application displays on-screen enrollment options to the user when the user presses the given remote control key, wherein the user may select a desired wager amount with the wager options using remote control arrow keys (Column 13, lines 41-47, and Figures 1-26).

Regarding Claims 15, 48, and 85:

- monitoring the user's activities to determine which types of wagers the user's activities to determine which types of wagers the user has made with the interactive wagering application (Column 2, line 35-Column 5, line 37).

Regarding Claims 16, 18, 31, 32, 49, 68, 69, 86, 88, 101, and 102:

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- monitoring the user's activities to determine which types of wagers the user has made with the interactive wagering application, wherein the content of the notification depends on which types of wagers the user has made (Column 2, line 35-Column 5, line 37).

Regarding Claims 19, 56, and 89:

- displaying the wagering-related promotional material as a partial-screen overlay on top of the television programming (Column 12, lines 11-14).

Regarding Claims 26, 63, and 96:

- collecting information on the user's past wagers (Column 2, line 35-Column 5, line 37).

Regarding Claims 27, 32, 64, and 97:

- collecting information on which wagers the user has won (Column 2, line 35-Column 5, line 37).

Regarding Claims 28, 65, and 98:

- the wagering-related promotional materials comprise an advertisement containing video (Column 2, line 35-Column 5, line 37).

Regarding Claims 29, 66, and 99:

- the wagering-related promotional materials are interactive materials that provide the user with an opportunity to sign up for an interactive wagering television channel (Column 2, line 35-Column 5, line 37).

Regarding Claims 30, 67, and 100:

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- the wagering-related promotional materials are interactive materials that provide the user with an opportunity to sign up for an interactive wagering service (Column 2, line 35-Column 5, line 37).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 4, 5, 10-14, 17, 20-24, 37, 38, 43-47, 50, 57-61, 73-75, 80-84, 87, 90-94, 103, and 104 are rejected under 35 U.S.C. 103(a) as being unpatentable over Handelman (E.P. 620,688A2) in view of Schein et al. (WO 97/48230).

Handelman discloses that as discussed above with regards to claims 1, 2, 3, 6, 8, 9, 15, 16, 18, 19, 26-36, 39-42, 48, 49, 51, 55, 56, 63-72, 76-79, 85, 86, 88, 89, and 96-102.

Handelman seems to lack explicitly disclosing:

Regarding Claim 73:

- the notification is displayed in response to a determination by the wagering application that the television programming is related to wagering.

Regarding Claims 4, 37, and 74:

- the notification is displayed in response to a determination by the wagering application that the television programming is related to equine themes.

Regarding Claims 5, 38, and 75:

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- the notification is displayed in response to a determination by the wagering application that the television programming is related to sports.

Regarding Claims 10, 43, and 80:

- monitoring the user's activities with the user equipment.

Regarding Claims 11, 44, and 81:

- monitoring the user's activities with the user equipment to determine which television programs the user watches.

Regarding Claims 12, 45, and 82:

- monitoring the user's activities with the user equipment to determine which television programs the user watches, wherein the content of the notification depends on which television programs the user watches.

Regarding Claims 13, 46, and 83:

- the content of the notification depends on the content of the television programming that is being displayed.

Regarding Claims 14, 47, and 84:

- monitoring the user's activities with the user equipment to determine which preferences are set by the user, wherein the content of the notification depends on which preferences are set.

Regarding Claims 20, 57, 90, 103, and 104:

- monitoring the user's activities to determine which television programs the user watches, wherein information on which programs are being watched is collected

using program guide database information that is distributed to the user equipment from a program guide data source.

Regarding Claims 17, 21, 50, 58, 87, and 91:

- displaying the television programming on the user equipment comprises displaying the television programming on a monitor using a computer.

Regarding Claims 22, 59, and 92:

- monitoring the user's activities comprises collecting information on which program guide settings the user establishes.

Regarding Claims 23, 60, and 93:

- monitoring the user's activities comprises collecting information on which interactive wagering application settings the user establishes.

Regarding Claim 24, 61, and 94:

- monitoring the user's activities comprises collecting information on which television channel the user is currently watching.

Regarding claims 4, 5, 10-14, 17, 20-24, 37, 38, 43-47, 50, 57-61, 73-75, 80-84, 87, 90-94, 103, and 104, Schein et al. teaches of a system and method for obtaining information from an electronic program guide, which allows the user to identify interested programs without searching through the entire program guide, can be provided by a television system, a set-top box, a VCR, or a computer. In one embodiment of the invention, whenever the user watches a program the interactive system, operating in the background, searches for programs which appear similar to the program currently being watched. If additional programs are found which may be of interest, the system identifies the user by placing a small icon on the screen.

It would have been obvious to one having ordinary skill in the art, at the time of the applicant's invention, to use the monitoring features of Schein in Handelman. Doing so enables the interactive gaming system to automatically search for programs containing desirable characteristics by entering certain attributes into the system. The interactive gaming system then identifies programs which meet the user's requirements.

6. Claims 25, 62, and 95 are rejected under 35 U.S.C. 103(a) as being unpatentable over Handelman (E.P. 620,688A2) in view of Schein et al. (WO 97/48230) and further in view of Brenner et al. (U.S. 5,830,068).

Handelman in view of Schein et al. teaches that as discussed above with regards to claims 4, 5, 10-14, 17, 20-24, 37, 38, 43-47, 50, 57-61, 73-75, 80-84, 87, 90-94, 103, and 104.

Handelman in view of Schein et al. seems to lack explicitly stating

Regarding Claims 25, 62, and 95:

- displaying the wagering-related promotional material in a scroll.

Brenner et al. teaches of an interactive wagering system and process for off-track wagering where previously known methods of displaying, e.g. scrolling can be used to provide wagering-related information on a monitor (Column 14, lines 4-18).

It would have been obvious to one having ordinary skill in the art, at the time of the applicant's invention, to utilize the well known scrolling display method of Brenner et al. in Handelman in view of Schein et al. Doing so would enable a user an additional way to obtain information on an upcoming wagering event.

Allowable Subject Matter

7. Claims 52, 53, and 54 are allowed because Handelman and Brenner et al. lack disclosing, teaching, or fairly suggesting to one of ordinary skill in the art the limitation, “automatically providing the user with an opportunity to electronically place a wager with the interactive wagering application in response to the pressing of the remote control key, wherein providing the user with an opportunity to electronically place the wager with the interactive wagering application comprises providing the user with interactive wagering options in which at least the racetrack has been preselected.”

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Tims '626, Holch et al. '328, Handelman et al. '336, Lappington et al. '035, Lett '822, Xidos et al '149, Woodfield et al. '523, Erlin '756, LaDue '808, McKeown et al. '199, Wilson et al. '258, and Mir et al. '887 disclose interactive television and game systems.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott E. Jones whose telephone number is (703) 308-7133. The examiner can normally be reached on Monday - Thursday, 6:30 A.M. - 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on (703) 308-2064. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Scott E. Jones
Examiner
Art Unit 3713

sej

A handwritten signature in black ink, appearing to read "Scott E. Jones", is positioned below the typed name and title.